

REMARKS

Favorable reconsideration and allowance of the present application is respectfully requested.

Currently, claims 1-30, including independent claims 1, 13, 22, and 28-29, remain pending in the present application. For example, independent claim 1 is directed a heat transfer material comprising a substrate layer, a release coating layer, a peelable film layer overlying the release coating layer, and an opaque crosslinked polymer layer overlying the peelable film layer. Although other layers may be used, such as between the peelable film layer and the opaque crosslinked polymer layer, the heat transfer material of claim 1 at least requires the presence of the recited layers.

In the Office Action, claims 1-30 were provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-32 of copending Application No. 10/003,698 ("the '698 application"). Applicant respectfully submits, however, that the claims of these applications are not identical so as to warrant a "same invention" type double patenting rejection under §101. In determining whether "same invention" type double patenting exists, one may ask the following:

Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

M.P.E.P. §804.01. When viewed in this manner, it is clear that the present claims do not claim the "same invention" as claims 1-32 of the '698 application. Specifically, each claim of the '698 application requires a discontinuous polymer layer. Claims 1-30 of the present application, however, encompass embodiments in which a polymer layer is

discontinuous and not discontinuous. So, an embodiment in which the layer is not discontinuous falls within the scope of the present claims, but does not presently fall within the scope of the claims of the '698 application. Thus, Applicant respectfully submits that the present claims define patentable subject matter under 35 U.S.C. §101.

Likewise, in the Office Action, it was stated that independent claim 22 would be objected to under 37 C.F.R. §1.75 as being a substantial duplicate of independent claims 1 if independent claim 1 were found to be allowable. However, Applicant respectfully notes that claim 1 requires an "opaque crosslinked polymer layer", while claim 22 requires a "crosslinked printable polymer layer." Thus, claim 22 would include embodiments in which the layer were "opaque" and "not opaque." Moreover, the mere inclusion of the language "comprising" in the claims is not determinative of whether they are substantial duplicates. Were this the case, a claim "comprising" only element "A" could be considered a substantial duplicate of a claim requiring elements "A", "B", "C", and "D". Accordingly, Applicant respectfully submits that claims 1 and 22 are not substantial duplicates.

Besides the above-mentioned rejection, independent claims 1, 13, 22, and 28-29 were also rejected in the Office Action under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,232,267 to Oshima, et al. Oshima, et al. is directed to a thermal transfer sheet. As shown in Fig. 1, for example, the thermal transfer sheet 1 may include a receptor layer-transferring portion 11, a dye layer-transferring portion 12, and a white layer-transferring portion 13. These portions 11, 12, and 13 are positioned side-by-side. The portion 11 includes a release layer 7, a receptor layer 8, and an adhesive

layer 9. The portion 12 includes dye layers 4Y, 4M, and 4C. Finally, the portion 13 includes a peeling layer 5 and a white layer 6.

To the contrary, independent claims 1, 13, 22, and 28 require (i) a substrate layer, (ii) a release coating layer, (iii) a peelable film layer overlying the release coating layer, (iv) and a crosslinked polymer layer overlying the peelable film layer. Similarly, independent claim 29 requires applying a release coating layer onto a substrate layer, applying a peelable film coating onto the release coating layer, and applying a crosslinked layer over the peelable film coating.

Nowhere does Oshima, et al. disclose such a construction for a heat transfer material. For instance, the receptor layer-transferring portion 11 of Oshima, et al. includes only a release layer 7, a receptor layer 8, and an adhesive layer 9. Even if the release layer 7 and receptor layer 8 were somehow construed to constitute the claimed “release coating layer” and “peelable film layer”, respectively, the adhesive layer 9 of Oshima, et al. is *not* a crosslinked layer. Instead, Oshima, et al. indicates only that the adhesive layer 9 may include a polyacrylate, an acrylate copolymer, and if necessary, a reinforcement agent, a plasticizer, a filler, and the like. (Col. 12, ll. 42-39). In fact, the purpose of the adhesive layer 9 of Oshima, et al. is entirely different than the purpose of the claimed crosslinked layer. Namely, the adhesive layer 9 is used to improve the adhesion of the receptor layer 8 to the transfer receiving material 15. On the other hand, an opaque crosslinked layer, for example, may inhibit graying and loss of opacity of the image when the substrate has a dark color. Likewise, a crosslinked printable layer may inhibit penetration of the image, dyes, or pigments into an opaque layer or into a light-colored fabric. Accordingly, for at least the reasons set forth above,

Applicant respectfully submits that independent claims 1, 13, 22, and 28-29 patentably define over Oshima, et al.

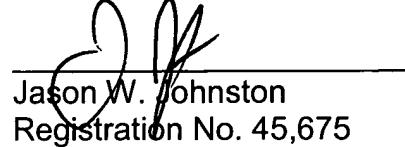
In addition, the above-cited reference was also cited alone or in combination with U.S. Patent No. 5,508,105 to Orensteen, et al. to reject dependent claims 2-12, 14-21, 23-27, and 30. Applicant respectfully submits, however, that at least for the reasons indicated above relating to the corresponding independent claims, dependent claims 2-12, 14-21, 23-27, and 30 patentably define over the references cited. However, Applicant also notes that the patentability of dependent claims 2-12, 14-21, 23-27, and 30 does not necessarily hinge on the patentability of the independent claims. In particular, some or all of these claims may possess features that are independently patentable, regardless of the patentability of the independent claims.

In summary, Applicant respectfully submits that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Dicus is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

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